

Appl. No.: 09/954,911

Response dated September 30, 2005

REMARKS

The Amendment

Claims 1, 4, 6, 8, 9, and 13-17 are pending after entry of the Amendment. Applicants have amended claim 1 such that the shear thinning, sprayable gel comprises from about 30 to about 65 percent by weight of the water-miscible solvent selected from the group consisting of glycols, alcohols and esters, and from about 0.4 to about 2 percent by weight of the clay gelling agent, each based on total weight of the composition. Support for the amendment is found in claims 3, 5 and 7. Claims 3, 5 and 7 are canceled. Claims 4, 6 and 8 are amended to depend from claim 1. Applicants respectfully submit that no new matter is introduced via the Amendment.

Rejections under 35 U.S.C. §102

Claims 1, 6, 9, 13, 15 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 5,484,816 to Yanagida et al ("Yanagida"). Applicants respectfully traverse.

The current amendment to claim 1 incorporates the elements of claim 7 therein, which included the elements of claims 3 and 5 by its dependency on claim 5. Effectively, claim 1 now reads as claim 7 prior to the amendment. Applicants note that claim 7 was not rejected under 35 U.S.C. §102(b) and respectfully submit that claim 1 and claims 6, 9, 13, 15 and 16, via their dependency on claim 1, are not anticipated by Yanagida. Accordingly, Applicants respectfully respect that the rejection of all claims under 35 U.S.C. §102(b) be withdrawn.

Rejections under 35 U.S.C. §103

Claims 4, 7, 8 and 17 are rejected under 35 U.S.C. §103(a) as being as being unpatentable over Yanagida. Applicants respectfully traverse.

As noted above, pending claim 1 now includes all of the claim elements of previously presented claim 7, which is canceled by this Amendment. Applicants thus will address the rejection under 35 U.S.C. 103(a) in view of Yanagida as if applied to currently pending claim 1. Claims 4, 8 and 17 depend on claim 1.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

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reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference or references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d, 1438 (Fed. Cir. 1991) and MPEP 2142 and 2143. The PTO has the burden under section 103 of establishing a *prima facie* case of obviousness. This burden can only be satisfied by showing some objective teaching in the prior art or that knowledge generally available in the art would lead one of ordinary skill in the art to combine the relevant teachings of the reference. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

Initially, Applicants respectfully submit that Yanagida does not provide the requisite suggestion or teaching that would motivate one skilled in the art to modify Yanagida as suggested by the Examiner to achieve the physically stable, shear thinning, sprayable gel compositions claimed by Applicants. Yanagida describes a variety of external skin treatment compositions including emulsions, creams, lotions, cosmetic oil formulations and gels, in which the stability of Vitamin A is improved. As noted in the Background of Yanagida, Vitamin A is unstable and can cause isomerization, decomposition, polymerization, etc., with light, air, heat, metal ion, etc. Thus, Yanagida is concerned with improving the structural stability of Vitamin A, not physical stability of the compositions discussed therein. Applicants respectfully submit that Yanagida does not address a shear thinning, sprayable gel composition as claimed by Applicants, nor is there any indication in Yanagida that gels disclosed therein are shear thinning or sprayable. Accordingly, Applicants respectfully submit that Yanagida, as a whole, fails to provide any suggestion or teaching to one skilled in the art as to compositions claimed by Applicants.

As recited in claim 1, Applicant's invention is a shear thinning, sprayable gel composition comprising from about 30 to about 65 percent by weight of a water-miscible solvent selected from the group consisting of glycols, alcohols and esters, from about 0.4 to about 2 percent by weight of a clay gelling agent, and from about 0.01 to about 0.05 by weight of at least one viscosity stabilizer selected from salts, acids and combinations thereof, each percent based on the total weight of the composition. The Examiner states that, while Examples 14-2 and 14-8 contain less water-miscible solvent than is claimed in claim 1, other examples, e.g. Example 9-4,

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contain as much as 30 percent glycol. Applicants respectfully note that Example 9-4 is a "beauty essence" that contains no clay gelling agent and no viscosity stabilizer as required by claim 1. As such, Applicants respectfully submit that Example 9-4 in and of itself does not suggest the composition claimed by Applicants and, in fact, would teach away from Applicants invention that contains a clay gelling agent and viscosity stabilizer.

Regarding compositions containing clay gelling agents, for example Examples 14-1 through 14-11, Applicants respectfully submit that Yanagida fails to suggest compositions according to the present invention. In addressing claim 4 prior to the Amendment and referring to col. 9, lines 38-47 of Yanagida, the Examiner states that, "It is the Examiner's opinion that determination of optimal or workable amount of clay with the reference's generic disclosure by routine experimentation is obvious and within the skill of the art. One having ordinary skill in the art would have been motivated to do this to obtain the desired gelling properties of the composition." Initially, Applicants submit that the "desired gelling properties" referred to in Yanagida are in context of compositions disclosed in Yanagida and are not in context of Applicants' claimed shear thinning, sprayable gel compositions. In addition, Yanagida states that clays may be used anywhere from 0.01% up to 50 %, but that "the upper limit of the formulation cannot be particularly set". Based upon the disclosure in Yanagida of the extremely broad range of clay, the reference to "properties" unrelated to shear thinning, sprayable gels, and the express statement by Yanagida as to uncertainty in the selection of upper limits of clay, Applicants respectfully submit that selection of Applicants claimed range of clay is not a result of routine optimization, as indicated by the Examiner.

Regarding the water-miscible solvent, at col. 9, line 25 through col. 10, line 42, where clay containing compositions are discussed, no mention of water-miscible solvents is made in reference to the amount of clay used and Yanagida is silent as to the amount of water-miscible solvent that "should" be used in combination with the gelling agent. At Col. 10, lines 47-51, it is mentioned that other conventional components, e.g. alcohol, can be used, although again there is no suggestion as to how much. Upon a thorough review of Examples 14-1 through 14-11, nowhere is there disclosed or suggested compositions that include clay gelling agents, viscosity

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stabilizers and water-miscible solvents, each as claimed by Applicants and each in the relative amounts as claimed by Applicants.

Based on all of the foregoing, Applicant's respectfully submit that all pending claims patentable over Yanagida under 35 U.S.C. 103(a) and respectfully request that rejections under 35 U.S.C. 103(a) be withdrawn.

Claim 14 is rejected under 35 U.S.C. §103(a) as being unpatentable over Yanagida in view of 4,543,251 to Kamishita ("Kamishita"). Initially, based on the foregoing alone, Applicants submit that claim 14 is not rendered obvious by this combination of references.

Furthermore, Kamishita teaches gel preparations prepared from diclofenac sodium. L-menthol may be added to impart a cool feeling to the skin (col. 3, lines 40-45). Kamishita does not describe or suggest Applicant's invention as recited in claim 1. Kamishita only teaches using l-menthol to impart a cool feeling to the skin. Thus, Applicants invention, as recited in claim 14, is patentable over this combination of references. Accordingly, the Applicants respectfully request that this rejection be withdrawn.

Conclusion

The applicants submit that none of the claims, presently in the application, is anticipated under the provisions of 35 U. S. C. § 102 or obvious under 35 U.S.C. 103(a). Consequently, the applicants believe that all of the claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

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If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. William (Kent) Wissing, at (732) 524-6201, so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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Dated: September 30, 2005